



UNITED STATES PATENT AND TRADEMARK OFFICE

OCT - 6 2005

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

FISH & RICHARDSON, PC
12390 EL CAMINO REAL
SAN DIEGO, CA 92130-2081

In re Application of :
John R. McDonald et al :
Serial No.: 09/360,242 : PETITION DECISION
Filed: July 2, 1999 :
Attorney Docket No.: 17080-002002 :

This is in response to the petition under 37 CFR 1.181, filed June 10, 2005, requesting withdrawal of the Final rejection, mailed April 7, 2005.

BACKGROUND

A review of the file history shows that the examiner mailed a Final Office action to applicants on February 18, 2004, setting a three month shortened statutory period for reply. Claims 26-29, 31-32, 34-37, 40, 42, 44-46, 48-54, 57 and 65-95 were rejected under 35 U.S.C. 112, first paragraph, for lack of enablement. All other rejections were withdrawn and the action was made Final.

Applicants replied on August 18, 2004, by filing RCE papers with a response and a request and fee for a three month extension of time. Applicants further amended claims 29, 31, 40, 86 and 87 and added claims 96-97. Applicants replied to the lone rejection with 39 pages of argument.

The examiner mailed a Final Office action to applicants on April 7, 2005, setting a three month shortened statutory period for reply. The examiner again rejected claims 26-29, 31-32, 35-37, 40, 42, 44-46, 48-54, 57 and 65-95 and new claims 96-97 under 35 U.S.C. 112, first paragraph, for lack of enablement as the sole rejection and made the action Final.

Applicants then filed this petition on June 10, 2005. The examiner in view of the petition then withdrew the finality of the Office action, mailed April 7, 2005, and mailed a revised final Office action to applicants on August 10, 2005.

DISCUSSION

Applicants requested withdrawal of the finality of the Office action of April 7, 2005, even though the rejection set forth is on the same basis as in Final Office action, mailed February 18, 2004. The examiner's action has rendered decision on this petition moot as the examiner *sua sponte* withdrew the finality of the Office action and prepared a new Office action.

The petition is **DISMISSED**.

Applicants remain under obligation to reply to the new Office action mailed August 10, 2005, within the time period set, or as extended under 37 CFR 1.136(a).

Should there be any questions about this decision please contact William R. Dixon, Jr., by letter addressed to Director, TC 1600, at the address listed above, or by telephone at 571-272-0519 or by facsimile sent to the general Office facsimile number 571-273-8300.

A handwritten signature in black ink, appearing to read "George C. Elliott". The signature is written in a cursive, flowing style.

George C. Elliott
Director, Technology Center 1600